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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,288

Applicant(s)

PETROVIC

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-38 is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 20-26 is/are rejected.
- 7) ☒ Claim(s) 2 and 8-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/403,272.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-38 are pending in this application and have been examined.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 7 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,683,958 B1. This is a double patenting rejection. Claim 7 of the instant application claims the identical method for encoding information symbols onto a host signal, albeit in very slightly different language.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 3-6, and 20-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Leighton (US 5949885).

Art Unit: 2137

As for claim 1, Leighton teaches a method for detecting the presence of auxiliary information symbols encoded onto host signals, comprising steps of: receiving an encoded host signal (col. 3 lines 55-67); detecting an auxiliary information carrier from said received encoded host signal (col. 3 lines 55-67), wherein said auxiliary information carrier is comprised of a plurality of signal components having varying amount of delay or offset from each other (col. 3 lines 30-35); correlating said encoded host signal with said auxiliary information carrier to obtain a correlation value (col. 3 lines 55-67); and detecting the presence of said auxiliary information symbols from said correlation value (col. 3 lines 55-67).

As for claim 3, Leighton teaches the method according to claim 1, wherein said auxiliary information symbol detecting step comprises the step of determining the magnitude of said correlation (col. 4 lines 1-10).

As for claim 4 Leighton teaches the method according to claim 1, wherein said auxiliary information symbol detecting step is used for copy management purposes (col. 4 lines 30-40).

As for claim 5, Leighton teaches the method according to claim 1, wherein said auxiliary information symbol detecting step is used to limit unauthorized copying of said host signal (col. 4 lines 30-40)

Art Unit: 2137

As for claim 6, Leighton teaches the method according to claim 1, wherein said auxiliary information symbol detecting step is used for at least one of broadcast and playback monitoring of said host signal (col. 1 line 21).

As for claim 20, Leighton teaches a method for encoding information symbols onto a host signal, comprising: providing an information carrier signal comprising one or more features of said host signal (col. 3 lines 1-10), determining a value of an auxiliary information signal representing an information symbol (col. 3 lines 17-55); calculating one or more values for modifying said information carrier signal in accordance with said auxiliary information symbol (col. 3 lines 17-55); developing a host modifying signal for modifying said host signal based upon said calculated values; and modifying said host signal with said host modifying signal (col. 17 line 55).

As for claim 21, Leighton teaches the method of claim 20, wherein said features comprise at least one of filtered, masked, or shifted versions of said host signal (col. 3 lines 56 through col. 4 line 4).

As for claim 22, Leighton teaches the method of claim 20, wherein said features are determined in at least one of time, frequency, or space domains (col. 3 lines 44-46).

Art Unit: 2137

As for claim 23, Leighton teaches the method of claim 20, wherein said host-modifying signal comprises a plurality of signal components having varying amounts of delay or offset from each other (col. 3 lines 30-67).

As for claim 24, Leighton teaches the method of claim 23, wherein the amount of delay or offset associated with said plurality of signal components is adapted in accordance with said auxiliary information symbols (col. 3 lines 30-67).

As for claim 25 Leighton teaches the method of claim 20, wherein said host modifying signal is obtained by modulating at least one of the amplitude or phase of the host signal (col. 3 lines 50-55).

As for claim 26, Leighton teaches the method of claims 20, wherein said modifying step is carried out in an analog domain (col. 3 lines 51-55).

Allowable Subject Matter

7. Claims 27-38 are allowed.
8. Claims 2 and 8-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent document teaches features pertinent to the Applicant's disclosure"

Adelson US 4,939,515

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

6/25/05

